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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,229	01/13/2005	Toyoki Nishijima	05006/HG	2770

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EXAMINER

LETSCHER, GERALDINE

ART UNIT PAPER NUMBER

1752

DATE MAILED: 10/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/521,229

Applicant(s)

NISHIJIMA ET AL.

Examiner

Geraldine V. Letscher

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1-13-05 & 3-4-05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/13/05 & 3/4/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-16 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The chromaticity indexes "a" and "b" are critical or essential to the practice of the invention, included in the claim(s) but NOT enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Each of claims 1-3 and 7-9 make reference to "a" and "b" as being defined in JIS-Z-8730 and measured in accordance with a method defined in JIS-Z-87-22. However, the specification does not disclose either the definition of "a" and/or "b", or the method by which "a" and/or "b" is measured.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-3 and 7-9 are rejected as being vague and indefinite when they each recite "a and b are *defined in JIS-Z-8730* and measured in accordance with a method *defined in JIS-Z-87-22*" (emphasis added); the scope of the protection sought by reference to the Japanese Industrial Standard is not clear.

5. Claims 3 and 7-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3 and 7 are rejected as being vague and indefinite when they each recite "wherein the photographic material contains a compound represented by formula (1) as *claimed in claim 1*" (emphasis added); the scope of the protection sought is not clear. Claim 1 is drawn to an image forming method.

Claim 8 is rejected as being vague and indefinite when it recites "wherein the photographic material contains a compound represented by formula (2) as *claimed in claim 5*" (emphasis added); the scope of the protection sought is not clear. Claim 5 is drawn to an image forming method.

Claim 9 is rejected as being vague and indefinite when it recites "wherein the photographic material contains a compound represented by formula (3) as *claimed in claim 6*" (emphasis added); the scope of the protection sought is not clear. Claim 5 is drawn to an image forming method.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Takahashi et al. (U.S. Patent No. 6,686,137).

Takahashi et al. discloses an image forming method comprising the steps of exposing a silver halide photographic material, and processing a silver halide photographic material, wherein the processed photographic material exhibits chromaticity indexes "a" and "b" inclusive of the instant range (see claim 5) and wherein said photographic material contains a compound inclusive of the instant formula (1) (see the dyes in column 28, lines 13-60)

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-16 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Suematsu et al. (U.S. Patent No. 4,957,856).

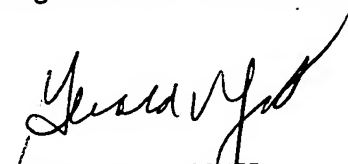
Suematsu et al. discloses an image forming method comprising the steps of exposing a silver halide photographic material, and processing a silver halide photographic material, wherein said photographic material contains a compound represented by formula (II) (column 2, line 50+) inclusive of the instant formula (1). Although Suematsu et al. does not specify the chromaticity indexes "a" and "b" of the

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processed photographic material, Suematsu et al. discloses the image forming method and silver halide photographic material of the instant claims, it is asserted that the processed photographic material inherently possesses the recited chromaticity indexes "a" and "b", and that the claimed image forming method and silver halide photographic material lack novelty, absent object evidence to the contrary. Assuming arguendo that the processed photographic material does not possess the recited chromaticity indexes "a" and "b", then Suematsu et al. is also relied upon under 35 USC 103 because it would have been obvious to one of ordinary skill in the requisite art at the time the invention was made to process the photographic material in order to achieve a satisfactory visual whiteness and image quality, with reasonable expectations of achieving, absent object evidence to the contrary the advantages generally taught therein.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geraldine V. Letscher whose telephone number is (571) 272-1334. The examiner can normally be reached 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (571) 272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



GERALDINE LETSCHER
PRIMARY EXAMINER
GROUP 1100

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).